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Attorney Docket No. 24-008

REMARKS

Counsel for applicants wishes to thank the examiner for the courtesy of the interview on December 27, 2006. The following incorporates the substance of the interview.

Claims 1-9, 11-14 and 16 are pending. Claims 5-6 have been withdrawn. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

The applicants appreciate the indication that the finality of the prior office action was withdrawn.

Claims 1-4, 8-9, 11, 13-14 and 16 were rejected under 35 USC 102(b) as being unpatentable over U.S. Patent No. 5,516,581, Kreckel ("Kreckel"). The rejection is respectfully traversed for reasons including the following, which are provided by way of example.

Independent claims 1 and 3 as amended recite in combination, for example, "an adhesive layer in continuous direct contact and coextensive with the release surface of the long release sheet."

The office action asserts that Kreckel anticipates the invention as claimed. To the contrary, Kreckel fails to set forth each and every element found in the claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

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The office action cites Kreckel as teaching each recited element. Specifically, the office action cites Kreckel's sheet (26) as equivalent to the recited long release sheet, and Kreckel's layer (24) as equivalent to the recited adhesive layer. The office action then argues that Kreckel, FIG. 7 illustrates an adhesive layer (24) being in continuous contact and coextensive with the release surface of the long release sheet (26).

To the contrary, Kreckel's adhesive layer (24) is not both "in continuous direct contact and coextensive with" the release surface of sheet (26). Kreckel's tab (28) interrupts any contact between the adhesive layer (24) and the sheet (26) at least where the tab (28) is placed between the adhesive layer (24) and the sheet (26). Kreckel fails to anticipate the limitation that the adhesive layer is "coextensive" with the release surface and/or the limitation that the adhesive layer is "in continuous direct contact" with the release surface.

The office action does not state what portion of the surface of Kreckel's sheet (26) is considered to be the release surface of the long release sheet. If the examiner deems the entire upper surface of sheet (26) to be the release surface, then it is clear that Kreckel's adhesive layer (24) is not in "continuous direct contact" with the entire upper surface of sheet (26), because contact is interrupted by the tab (28). On the other hand, if the examiner deems the half of the surface of sheet (26) which is adjacent to the adhesive layer (24) to be the release surface, then it is clear that Kreckel's adhesive layer (24) is not "coextensive" with that half of the sheet (26), because the adhesive layer (24) does not have the same boundaries as that half of the sheet (26).

Kreckel fails to teach or suggests, for example, "an adhesive layer in continuous direct contact and coextensive with the release surface of the long release sheet." (See, e.g., claim 1.) To the contrary, Kreckel teaches "an adhesive-free tab 28 covers a portion of adhesive layer 24

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to provide for grasping tape 20 for easy removal from substrates to which it will be subsequently adhered.” (Col. 6, lines 34-37.)

Claim 1 further recites in combination, for example, “a protective material provided longitudinally on and in continuous contact with a generally peripheral portion of the second surface of the base material.” Independent claim 3 recites in combination, for example, “a protective material provided longitudinally on and in continuous contact with a generally peripheral portion of the back surface of the long release sheet.” The office action states that Kreckel’s tab (28) is equivalent to the recited protective material.

In Kreckel FIG. 7, Kreckel’s tab (28) is not provided longitudinally on the sheet (22). The tab (28) is provided for grasping the tape (20) for easy removal from a substrate to which it will be subsequently adhered (Col. 6, lines 34-37.) Therefore, the tab (28) should not be provided longitudinally on the sheet (22). Similarly, in Kreckel FIG. 10, notably the tab (124) is provided on an end of the tape, and not provided longitudinally on a peripheral portion of the sheet. In FIG. 10, the tab (124) is provided so that the tape may be easily grasped for removal as well (Col. 9, lines 38-39).

Claim 3 is additionally allowable for the reason that the examiner failed to make a proper *prima facie* case of anticipation. Furthermore, the examiner argues that the tab (28) is provided longitudinally on a peripheral portion of the base material (22) with respect to both claims 1 and 3. The office action therefore fails to address the limitations of claim 3 which call for the protective material to be provided on the back surface of the long release sheet, not the base material. Because the office action failed to address at least one limitation of claim 3, the examiner has failed to make a proper *prima facie* case of anticipation with respect to claim 3, and the rejection must be withdrawn.

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Kreckel fails to teach or suggest, for example, these elements recited in independent claims 1 and 3. It is respectfully submitted therefore that claims 1 and 3 are patentable over Kreckel.

For at least these reasons, the combination of features recited in independent claims 1 and 3, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, Kreckel clearly fails to show other recited elements as well.

With respect to the rejected dependent claims, the applicants respectfully submit that these claims are allowable not only by virtue of their dependency from independent claims 1 and 3, but also because of additional features they recite in combination, some of which are discussed below.

Amended dependent claim 2 recites that "a central portion of the adhesive layer in the widthwise direction thereof is the principally used portion of the adhesive layer, while the protective material is provided on both sides of the second surface of the base material spaced apart in the widthwise direction thereof." The office action argues that the tab (28) extends across the width of the base material (presumably from one side to the other), and hence "is located along both side edges of the base material." However, it should be noted that "a central portion of the adhesive layer in the widthwise direction is the principally used portion" (claim 2), "a protective material [is] provided ... on ... a generally peripheral portion (claim 1), and "the peripheral portion corresponds to a portion other than a principally used portion" (claim 1). However, the tab (28) extends across the width of the base material (according to the examiner's interpretation) and hence would correspond additionally to the central portion. Therefore, claim 2 cannot be anticipated by Kreckel.

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Amended dependent claim 4 recites that "a central portion of the adhesive layer in the widthwise direction thereof is the principally used portion of the adhesive layer, while the protective material is provided on both sides of the back surface of the release sheet spaced apart in the widthwise direction thereof." Claim 4 depends from claim 3; the examiner has not addressed claim 4 in particular, as discussed above in connection with independent claim 3. However, claim 4 is allowable for reasons similar to those provided in connection with claim 2, in addition to the reasons provided in connection with independent claim 3.

Claim 12 was rejected under 35 USC 103(a) as being unpatentable over Kreckel in view of official notice of adhesive tapes in roll form. The examiner stated in the interview that claim 7 was intended to be rejected for the same reasons as given for claim 12. Claims 7 and 12 recite that "when the laminate sheet is wound into a roll, the protective material serves as a spacer between the base material and the long release sheet." Because Kreckel's tape is not so long as to be wound into a roll (see any of Kreckel's figures), it would not have been obvious to combine Kreckel with official notice of adhesive tapes in roll form.

Furthermore, the examiner appears to be relying on personal knowledge to support the finding of what is known in the art. The taking of Official Notice is respectfully traversed, and the examiner is requested to provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. MPEP 2144.03 See 37 CFR 1.104(d)(2). An examiner cannot simply reach conclusions based on their own understanding, or experience, or assessment of what would be basic knowledge or common sense. Rather, there must be some concrete evidence in the record in support of these findings. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Moreover, the examiner's expertise "may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697.

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It appears that the examiner is utilizing the noticed fact to provide a motivation to modify Kreckel, hence, the noticed fact is clearly not a peripheral issue. Accordingly, it is inappropriate for the examiner to rely on official notice, and the examiner is requested to provide the above-mentioned affidavit or declaration if the examiner continues to rely on such Official Notice in rejecting claims 7 and 12.

The applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples the applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

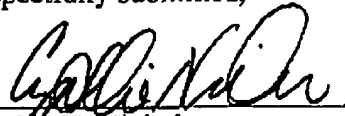
In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

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If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,



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